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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,351	12/21/2001	Gilles Rubinstenn	05725.1009-00	4841
22852	7590	08/25/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
EXAMINER				
BORISSOV, IGOR N				
ART UNIT		PAPER NUMBER		
3628				
MAIL DATE		DELIVERY MODE		
08/25/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/024,351

**Applicant(s)**

RUBINSTENN ET AL.

**Examiner**

Igor N. Borissov

**Art Unit**

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06/19/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

Amendment received on 05/29/2008 is acknowledged and entered. Claims 25-4 have been canceled. Claims 1, 11 and 24 have been amended. Claims 1-24 are currently pending in the application.

***Claim Rejections - 35 USC § 101***

**35 U.S.C. 101 reads as follows:**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1-19 and 24 are rejected under 35 U.S.C. 101** because the claimed invention is directed to non-statutory subject matter.

Claims 1-19 and 24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-19 and 24 are directed to a series of steps. In order for a series of steps to be considered a proper process under § 101, a claimed process should either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Thus, to qualify as patent eligible, these processes should positively recite the other statutory class to which it is tied (e.g., by identifying the apparatus which accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g., by identifying the product or material that is changed to a different state). Claims identify neither the apparatus performing the recited steps nor any transformation of underlying materials, and accordingly are directed to non-statutory subject matter.

Furthermore, 35 U.S.C. § 101 provides:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Traditional process can be understood as either transforming subject matter or implemented by one of the other three categories. See *Tilghman v. Proctor*, 102 U.S. 707, 722 (1880) ("where the result or effect is produced by chemical action, by the operation or application of some element or power of nature, or of one substance to another, such modes, methods, or operations are called processes."); see also *AT&T*, 172 F.3d at 1356, 50 USPQ2d at 1450 ("any step-by-step process, be it electronic, chemical, or mechanical, involves an 'algorithm' in the broad sense of the term.").

Method claims 1 and 24 do not recite any electrical, chemical, or mechanical acts or results, typical in traditional process claims; the claim does not require any machine or apparatus to perform the recited steps; and, finally, the claim does not provide any physical transformation of an article to a different state or thing, nor does it require any transformation of data or signals. However, "...a process claim [in] compliance with Section 101 requires some kind of transformation or reduction of subject matter." See *In re Schrader*, 22 F.3d 295, 30 USPQ2d at 1459.

So as the claims 1 and 24 does not require any machine or apparatus to perform the recited steps, and does not require implementing a mathematical formula or algorithm to transform data, the information recited in the claim does not represent a real world activity such as found in *Arrhythmia*, *Alappat*, or *State Street*. As such, claim 1 falls outside the scope of § 101 as failing to apply its abstract idea to produce a useful and concrete and tangible result.

As per system claim 11, the claim recites only a computer-readable medium and *means* for enabling the recited functionalities which (means) could be understood as

merely software or code per se. As such, it appears that the claim is directed to two statutory subject classes - an apparatus and product of manufacture. So as the remaining dependent claim do not cure the identified deficiencies of independent claims, they are also rejected as being directed to non-statutory subject matter.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney et al. (WO 01/18674 A2) in view of Otworth et al. (US 2002/0059030 A1).**

Maloney et al. (hereinafter Maloney) teaches a method and system and computer-readable medium for providing a customized product combination to a consumer, comprising:

**Independent Claims**

**Claims 1 and 11.**

storing personal questions on at least one topic including characteristics of at least one external body condition, the personal questions being stored on a computer-readable storage medium (page 8, lines 35 - page 9, lines 5; page 6, lines 30-34; page 18, lines 1-4, 21-24);

selecting a set of personal questions from the personal questions stored on the computer-readable storage medium (page 8, lines 35 - page 9, lines 5; page 6, lines 30-34; page 18, lines 1-4, 21-24);

asking a subject the set of personal questions on at least one topic including characteristics of at least one external body condition of the subject (page 11, lines 26-30);

receiving answers to the personal questions (page 11, lines 26-27);

providing the subject with at least one set of testing material for determining quantitative information that would aid in recommending at least one beauty product to the subject (page 11, lines 7-9), said "providing" step suggests a step of *selecting* of said *at least one* set of testing material;

informing the subject about the at least one set of testing material (page 11, lines 13-14).

While Maloney teaches selecting said at least one set of testing material, Maloney does not specifically teach that said set is selected *based on the received answers (subject's data)*; that said set of testing material is a *customized* set; and that said customized set is selected from a *plurality* of testing materials.

Otworth et al. teaches a method and system for analysis of remotely collected biological samples, and includes: *based upon collected historical data (subject's data)* related to a subject, providing the subject with a *customized* kit for collecting the biological sample from the subject, wherein said kit includes at least one replaceable cartridge which is determined/selected based on the tests determined to be conducted on the subject (*plurality* feature) [0043]; [0040].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include that said set is selected *based on the received subject's data*; that said set of testing material is a *customized* set; and that said customized set is selected from a *plurality* of testing materials, as disclosed in Otworth et al., because it would advantageously allow to accommodate said various profile sub-categories of consumers, thereby providing each customer with said customized test kit (Maloney; page 11, lines 6-10).

**Claim 20.** Maloney teaches a computer-readable medium having computer-executable instructions embedded therein which, when executed by the computer, causing said computer to implement a method for providing a customized product combination to a consumer, comprising:

asking a subject the set of personal questions on at least one topic including characteristics of at least one external body condition of the subject (page 11, lines 26-30);

receiving answers to the personal questions (page 11, lines 26-27);

providing the subject with at least one set of testing material for determining quantitative information that would aid in recommending at least one beauty product to the subject (page 11, lines 7-9), said "providing" step suggests a step of *selecting* of said *at least one* set of testing material;

informing the subject about the at least one set of testing material (page 11, lines 13-14).

While Maloney teaches selecting said at least one set of testing material, Maloney does not specifically teach that said set is selected *based on the received answers (subject's data)*; that said set of testing material is a *customized* set; and that said customized set is selected from a *plurality* of testing materials.

Otworth et al. teaches a method and system for analysis of remotely collected biological samples, and includes: *based upon collected historical data* related to a subject, providing the subject with a *customized* kit for collecting the biological sample from the subject, wherein said kit includes at least one replaceable cartridge which is determined/selected based on the tests determined to be conducted on the subject (*plurality* feature) [0043]; [0040].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include that said set is selected *based on the received subject's data (including answers)*; that said set of testing material is a *customized* set; and that said customized set is selected from a *plurality* of testing materials, as disclosed in Otworth et al., because it would advantageously allow to

accommodate said various profile sub-categories of consumers, thereby providing each customer with said customized test kit (Maloney; page 11, lines 6-10).

**Claim 24.** Maloney teaches:

storing personal questions on at least one topic including characteristics of at least one external body condition, the personal questions being stored on a computer-readable storage medium (page 8, lines 35 - page 9, lines 5; page 6, lines 30-34; page 18, lines 1-4, 21-24);

selecting a set of personal questions from the personal questions stored on the computer-readable storage medium (page 8, lines 35 - page 9, lines 5; page 6, lines 30-34; page 18, lines 1-4, 21-24);

asking a subject personal questions on at least one topic including characteristics of at least one external body condition of the subject (page 11, lines 26-30);

receiving answers to the personal questions (page 11, lines 26-27);

providing the subject with at least one set of testing material for determining quantitative information that would aid in recommending at least one beauty product to the subject (page 11, lines 7-9), said "providing" step indicates a step of *selecting* of said at least one customized set of testing material;

providing the subject with the set of testing material (page 11, lines 13-14);

ascertaining quantitative information by collecting data derived from use of the testing material on the subject (page 11, lines 15-16, 19-20);

recommending at least one beauty product to the subject based on the received answers and the ascertained quantitative information (page 12, lines 27-33).

While Maloney teaches selecting said at least one set of testing material, Maloney does not specifically teach that said set is selected *based on the received answers (subject's data)*; that said set of testing material is a *customized* set; and that said customized set is selected from a *plurality* of testing materials.

Otworth et al. teaches a method and system for analysis of remotely collected biological samples, and includes: *based upon collected historical data* related to a subject, providing the subject with a *customized* kit for collecting the biological sample



from the subject, wherein said kit includes at least one replaceable cartridge which is determined/selected based on the tests determined to be conducted on the subject (*plurality* feature) [0043]; [0040].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include that said set is selected *based on the received subject's data (including answers)*; that said set of testing material is a *customized* set; and that said customized set is selected from a *plurality* of testing materials, as disclosed in Otworth et al., because it would advantageously allow to accommodate said various profile sub-categories of consumers, thereby providing each customer with said customized test kit (Maloney; page 11, lines 6-10).

Dependent Claims

**Claims 2, 9, 10, 12, 18, 19 and 21.** Same reasoning as applied to claim 1.

**Claim 3.** See reasoning applied to claim 1.

**Claims 4, 13 and 22.** Maloney teaches: ascertaining quantitative information by collecting data derived from use of the testing material on the subject (page 11, lines 15-16, 19-20).

**Claims 5, 14 and 23.** Maloney teaches: recommending at least one beauty product to the subject based on the received answers and the ascertained quantitative information (page 12, lines 27-33).

**Claims 6 and 15.** Maloney teaches that the customized set of testing material includes at least one of a pH indicator, sebutape, and a corneodisque indicator (page 11, lines 11-12).

**Claims 7 and 16.** Maloney teaches that the questions are posed to the subject over a computer network (page 8, line 35 – page 9, line 2), and wherein the at least one customized set of testing material is delivered to the subject via a courier (column 11, line 18).

**Claims 8 and 17.** Maloney teaches selecting and shipping an appropriate (customized) set to a customer (page 11, lines 7-9 and 18). Furthermore, Maloney teaches profiling a consumer based on consumer's physiological preferences and

physiological conditions, said conditions including skin type and life stage, said profiling further includes assigning the consumer to various profile sub-categories which correspond to specific beauty product categories (page 6, line 32 – page 7, line 12), thereby suggesting that said selected (customized) set is readily available for each consumer in each of said profile sub-categories. Otworth et al. teaches that said kit includes at least one replaceable cartridge which is determined/selected based on the tests determined to be conducted on the subject [0043] (see reasoning applied to Claim 1), thereby suggesting *maintaining an inventory of a plurality of differing groups of customized sets of testing material, each group containing a combination of testing material different from a combination in another group*. The motivation to combine the references would be advantageously allowing to accommodate said various profile sub-categories of consumers, thereby providing each customer with said test kit (page 11, lines 6-10).

### ***Response to Arguments***

Applicant's arguments filed 05/29/2008 have been fully considered but they are not persuasive.

In response to applicant's argument that *Otworth* does not teach or suggest that the historical data related to the subject include "answers to [a] set of personal questions," as recited in claim 1, or that the historical data related to the subject are obtained through "asking the subject the set of personal questions" and "receiving answers to the set of personal questions," as recited in claim 1, it is noted that Maloney was applied to this feature (See the discussion above).

In response to applicant's argument that *Otworth* does not disclose determining a test kit "based on the received answers," as recited in claim 1, it is noted that *Otworth et al.* discloses determining a test kit "based on *collected historical data* related to a subject" [0043]; [0040]. As per "received answers" per se, Maloney was applied to this feature.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Igor N. Borissov/

Primary Examiner, Art Unit 3628

08/20/2008